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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,626	10/30/2000	Daniel J. Sullivan	1001.1413102	7050
28075	7590	06/16/2005		
CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			EXAMINER MARMOR II, CHARLES ALAN	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/699,626	<b>Applicant(s)</b> SULLIVAN, DANIEL J.	
	<b>Examiner</b> Charles A. Marmor, II	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is responsive to the Amendment filed March 29, 2005. The Examiner acknowledges the cancellation of claims 39-42. Claims 37 and 38 remain pending.

#### ***Drawings***

2. As previously noted on the PTO-326 of the Office Action mailed December 29, 2004, the formal drawings submitted on October 30, 2000 are acceptable.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. ('043) in view of Gambale et al. ('924), and further in view of Tanabe et al. ('879). Becker et al. teach a guidewire having an elongate solid shaft (116). The guidewire further comprises a proximal end and distal end with a taper towards its distal end (column 8, lines 31-32). A plurality of visually perceivable markers (122, 124, 126) are disposed on the core wire proximal of the coil tip (112) in a predetermined spatial relationship (See Fig. 6). Becker et al. does not teach that the coil tip is radiopaque. Gambale et al. teach that it is advantageous to form a guidewire having a distally tapered core (12) with a flexible coil tip (18) that is radiopaque so

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as to make the distal portion of the guidewire visually perceivable to a physician during the course of a fluoroscopic procedure in order to allow monitoring of the position and advancement of the guidewire within the body. Becker et al, as modified by Gambale et al. to include a radiopaque coil, also do not teach that the visually perceivable markers are radiopaque or are spaced 1.5 cm apart. Tanabe et al. teach that it is advantageous to provide an intravascular device (1) with a plurality of radiopaque markers (3) spaced axially therealong to allow an operator to easily ascertain the position of the device within the body of the patient during fluoroscopic procedure. The markers of Tanabe et al. are 1 mm wide (column 4, lines 18-21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the visually perceivable markers of Becker et al., as modified by Gambale et al., from radiopaque bands similar to those of Tanabe et al. in order to allow an operator to easily ascertain the position and orientation of the device fluoroscopically while the device is positioned within the body of a patient. Neither Becker et al. nor Tanabe et al. expressly teach that the markers are all spaced 1.5 cm apart. The Examiner notes that Applicant has failed to state why relatively non-radiopaque sections that are 1.5 cm wide and radiopaque sections that are 1 mm wide are critical to the present invention. It would have been an obvious design choice to one having ordinary skill in the art at the time the invention was made to use a plurality of evenly spaced markers at a distance of 1.5 cm separation with a guidewire similar to that of Becker et al. as modified by Gambale et al. and Tanabe et al. hereinabove, in order to provide visual confirmation position and orientation of the distal portion of the guidewire at all times.

Furthermore, "where the only difference between the prior art and the claims (is)  
a recitation of relative dimensions of the claimed device and a device having the

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claimed relative dimensions would not perform differently than the prior art device, the claimed device (is) not patentably distinct from the prior art device." MPEP 52144.04 citing Gardner B. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

### ***Response to Arguments***

5. Applicant's arguments, see pages 3 and 4 of the Remarks filed March 29, 2005, with respect to the rejection of claims 37 and 38 under 35 U.S.C. 103(a) as being unpatentable over Huter et al. ('511) in view of Doyle et al. ('434) and further in view of Moore et al. ('465) have been fully considered and are persuasive. Applicant persuasively argued that the Huter et al. patent is unavailable as prior art in view of its filing date. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Becker et al. ('043), Gambale et al. ('924), and Tanabe et al. ('879) as set forth hereinabove.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II  
Primary Examiner  
Art Unit 3736

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June 10, 2005